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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,900	09/28/2000	Stuart A. Fraser	99-1008	7800
63710 7590 08/22/2008 DEAN P. ALDERUCCI CANTOR FITZGERALD, L.P. 110 EAST 59TH STREET (6TH FLOOR) NEW YORK, NY 10022				
EXAMINER				
ZURITA, JAMES H				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
08/22/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/670,900

**Applicant(s)**

FRASER ET AL.

**Examiner**

JAMES ZURITA

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/18/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) Claims 1, 3-4, 6-16, 22, 31-34, 36-37, 50-53, 55-56, 71-74, 76-77, 92-95, 97-98, 113- 115, and 136-208 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are Claims 1, 3-4, 6-16, 22, 31-34, 36-37, 50-53, 55-56, 71-74, 76-77, 92-95, 97-98, 113- 115, and 136-208 .

## DETAILED ACTION

### ***Response to Amendment***

On 4 December 2007, applicant withdrew the application from appeal and amended claims 1, 13, 34, 53, 74, and 95 and dependent claims 3-4, 6-12, 14-16, 22, 31-33, 36-37, 50-52, 55-56, 71-73, 76-77, 92-94, 97-98, and 113-115.

On 4 December 2007, Applicant also cancelled claims 17, 20-21, 23-30, 35, 41-49, 54, 60-70, 75, 81-91, 96, 102-112, 116-119, and 123-135 and added claims 209-223. On 18 April 2008 applicant cancelled claims 209-223.

Claims 1, 3-4, 6-16, 22, 31-34, 36-37, 50-53, 55-56, 71-74, 76-77, 92-95, 97-98, 113-115, and 136-208 are pending in this application. Of these,

- Claims 1, 13, 34, 53, 74, and 95 are ***independent***
- Claims 3-4, 6-12, 14-16, 22, 31-33, 36-37, 50-52, 55-56, 71-73, 76-77, 92-94, 97-98, 113-115, and 136-208 are dependent.

### ***Response to Arguments***

Applicant's arguments of 12/04/2007 and 04/18/2008 have been carefully considered.

Applicant's arguments concerning Gebb and amended claims are moot in view of new grounds of rejection.

### ***Claim Objections***

Claim 34 is objected to because of the following informalities:

Claim 34 contains the improper designation (***currently presented***).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112 – first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

***Independent*** claim 53 and claims dependent thereon are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Independent*** claim 53 and claims dependent thereon are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 53, the limitation "...the item being non-transferable..." precludes step of "...causing the item to be transferred..."

Claims 140, 145, 160, 165, 175, 180, 194 and 204 and claims dependent thereon are likewise rejected in that the limitation "...the at least one restriction on transferability

comprises the item being non-transferable..." contradicts the limitations of their parent claims.

***Claim Rejections - 35 USC § 112 – second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 148, 168, 183, 188, 197 and 207 have the limitation "...the first consumer purchased the item directly or indirectly from the provider..." The use of the conditional **OR** renders the claim indefinite. Prior art will be interpreted to meet the limitation where prior art discloses any type of direct or indirect purchase.

In claims 140, 145, 160, 165, 175, 180, 194 and 204, the limitation "...restriction on transferability comprises the item being non-transferable..." renders the claim indefinite, since the limitation contradicts the limitation of parent claims. It is not clear how an item can be transferred yet be non-transferable.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-4, 6-16, 22, 31-34, 36-37, 50-53, 55-56, 71-74, 76-77, 92-95, 97-98, 113- 115, and 136-208 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (US 6,085,176).

As per **independent** claim 1, Woolston discloses method(s) comprising:

- receiving from a first consumer a request to transfer an item; Woolston, Fig. 9 and related text, as in Col. 14, lines 1-21.
- causing to be presented to the first consumer a plurality of options, in which the options comprise to transfer the item by auctioning the item and to transfer the item by advertising the item, in which advertising the item comprises posting a price; Woolston, at least Col. 3, lines 17-33, modes of operation.
- receiving from the first consumer a selection, in which the selection comprises one of: to transfer the item by auctioning the item, and to transfer the item by advertising the item; Woolston, at least Col. 3, lines 17-33
- requesting from a provider, which is not the first consumer, authorization to transfer the item; Woolston, at least Col. 17, lines 25-36,
- receiving from the provider authorization to transfer the item; Woolston, at least Col. 17, lines 10-22.
- based at least in part on receiving from the provider authorization to transfer the item, causing information about the item to be presented via a computer to at least a second consumer, (Woolston, user interfaces)

- in which the information is presented, at least in part, as part of an auction (Woolston, auction mode, Col. 3, lines 17-20) when the selection by the first consumer comprises to transfer the item by auctioning the item, and
- in which the information is presented, at least in part, as an advertisement when the selection by the first consumer comprises to transfer the item by advertising the item (Woolston, Col. 3, lines 16-33, posting in market mode, agent mode);
- receiving from the second consumer an indication to purchase the item; (Woolston, at least Col. 5, lines 20-50) and
- causing the item to be transferred from the first consumer to the second consumer. Woolston, at least col. 5, lines 20-30)

As per claim 13, **independent**, this claim, this claim is rejected on the same grounds as claim 1.

As per claim 34, **independent**, this claim, this claim is rejected on the same grounds as claim 1.

As per claim 53, **independent**, this claim, this claim is rejected on the same grounds as claim 1.

As per claim 74, **independent**, this claim, this claim is rejected on the same grounds as claim 1.

As per claim 95, **independent**, this claim, this claim is rejected on the same grounds as claim 1.

Woolston does not refer to Provider, first consumer and second consumers. However, the various labels do not affect the method steps. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Woolston to disclose Provider, first consumer and second consumers as actors because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Woolston does not specifically disclose each and every combination of conditions of transferability of applicant's claims. Official notice is taken that transfer of ownership is based on one or more conditions set by each party. It would have been obvious to extend Woolston to include combinations of conditions of transferability of applicant's claims because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Woolston does not specifically disclose each and every type of payment to an intermediary of applicant's claims. It would have been obvious to extend Woolston to include types of payment to an intermediary of applicant's claims because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/  
Primary Examiner  
Art Unit 3625  
18 August 2008